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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,654	02/03/2004	Peter W. Gavin	34814-10123	3525
2574	7590	01/23/2008		
JENNER & BLOCK, LLP ONE IBM PLAZA CHICAGO, IL 60611			EXAMINER WENDELL, MARK R	
			ART UNIT	PAPER NUMBER
			3635	
			MAIL DATE	DELIVERY MODE
			01/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/771,654

Applicant(s)

GAVIN, PETER W.

Examiner

MARK R. WENDELL

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claims 28-31 are objected to because of the following informalities: The claims have dependency from the cancelled claim 27. For examination purposes, the examiner will assume they are suppose to depend from claim 19. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17, 19-25, 27-30, 32-37, 39-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al. (US Patent Application Publication Number US 2002/0166291). Regarding claims 1-2, 19, 21-22, and 42 Campbell illustrates in Figure 6 a casting riser pan (130) comprising:

- An annular wall having a top and bottom portion (see modified figure below);
- An annular wall defining an opening and a wall generally corresponding to the periphery of a removable cover;

Art Unit: 3635

- An annular wall including an orientation portion forming an orientation element.
- A cover having an orientation element (see modified Figure below) which facilitates the seating of the cover on the pan in a predetermined angular orientation (0 or 90 degrees depending on of axis chosen).

However, Campbell does not teach the cover or structure being made of concrete. It would have been obvious to one having ordinary skill in the art at the time of invention to make the cover and structure from concrete, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (In re Leshin, 125 USPQ 416).

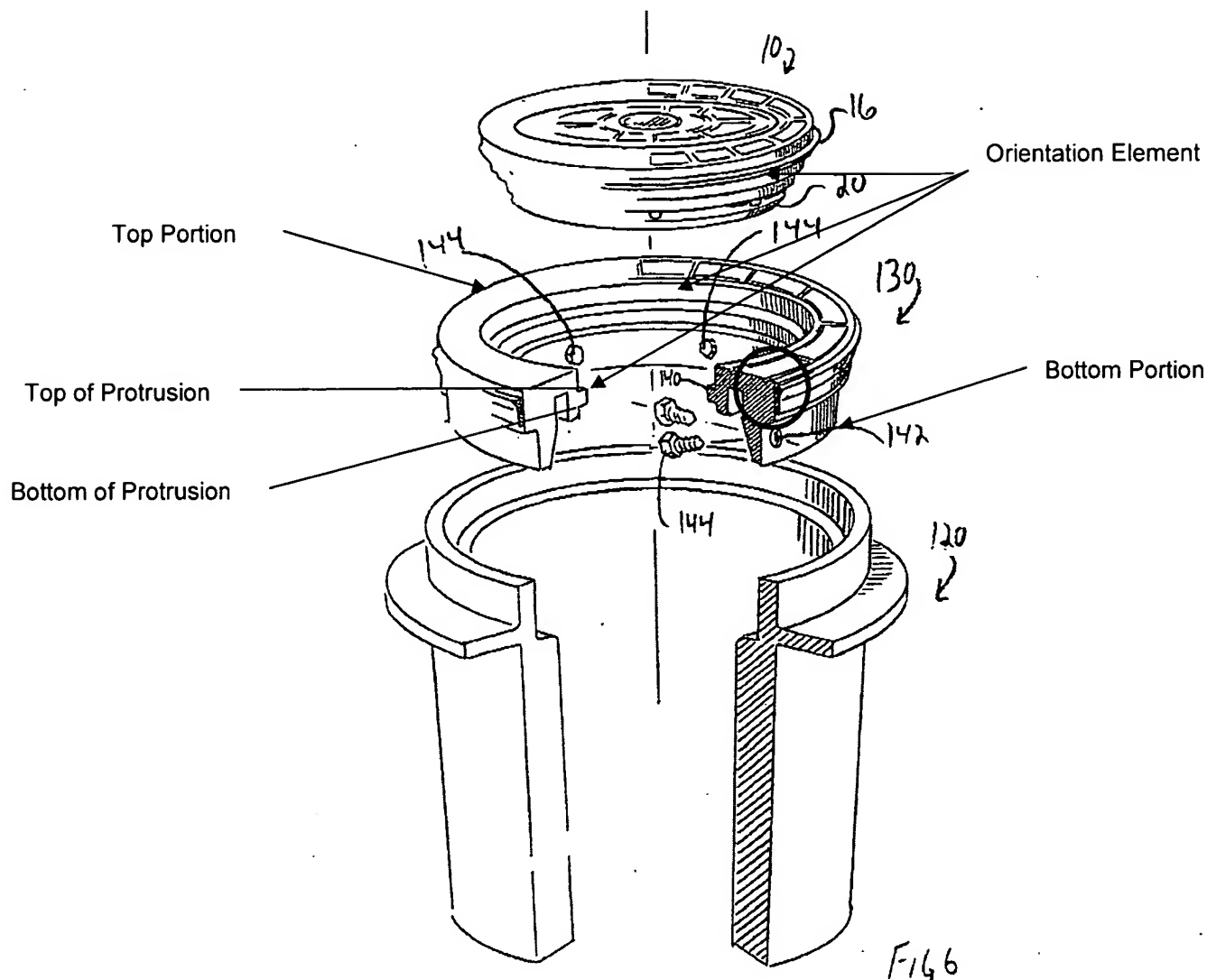


Figure 6 of Campbell et al.

Regarding claim 3, Campbell illustrates in Figure 6 the casting riser pan (130) tapering radially outward from bottom to top. The examiner notes that the circled portion in the figure above is tapered outward further than the labeled bottom portion, thus giving rise to the casting riser pan tapering radially outward from bottom to top.

Art Unit: 3635

Regarding claims 4-9, Campbell illustrates in Figure 6 the casting riser pan wall having an upper and lower portion and a protruding transverse shoulder (140) extending inwardly between the two.

Regarding claims 6 and 7, the orientation element (labeled above) comprises a protrusion (140), having a top and bottom portion, extending radially inward, thus defining a recess (20) in the cover.

Regarding claims 10-13 and 15-16, Campbell illustrates in Figure 6 a casting riser pan comprising:

- A securing element extending radially inward from the bottom portion of the wall (see modified figure below);
- A weakened region connecting the securing element to the bottom portion;
- A securing element including attachment holes (142) with fasteners;
- An end portion to be received by a stackable riser (120).

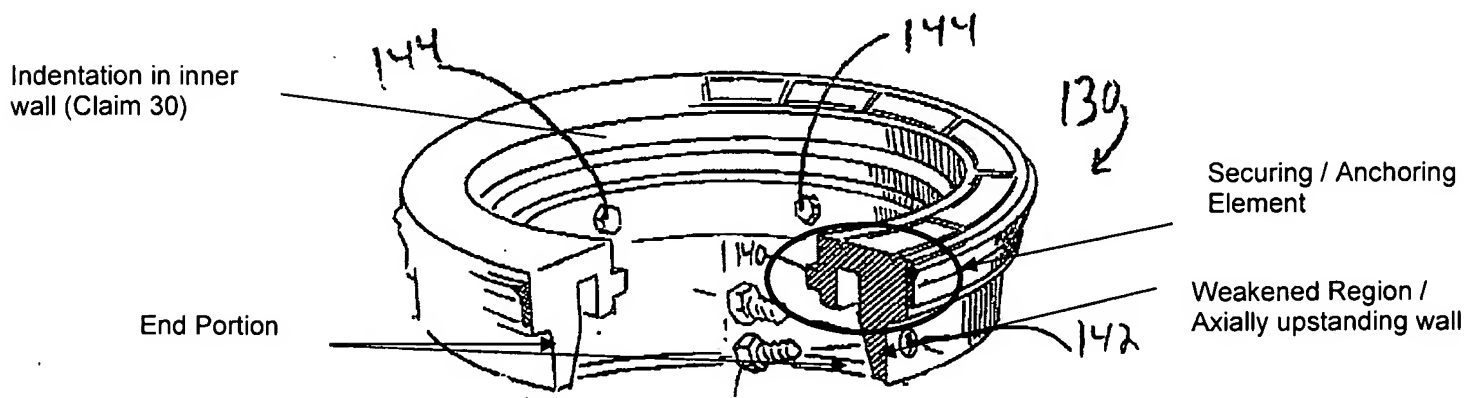


Figure 6 of Campbell

Art Unit: 3635

The examiner notes that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (In re Hutchison, 69 USPQ 138). Regarding claims 10, 12-13 and 15, the structure of Campbell has the ability to perform the actions referred to in the claims.

Regarding claims 17-18, Campbell illustrates in Figure 6 a casting riser pan (130) in combination with a stackable riser (120).

Regarding claim 20, Campbell illustrates in Figure 6 a casting riser pan (130) with the outer wall extending angularly outward from the inner wall. The outer wall extends outwardly at an angle of 180 degrees, which meets the limitation of extending angularly outward.

Regarding claim 23, Campbell illustrates in Figure 6 a casting riser pan (130) with the inner wall tapering radially outward from bottom to top.

Regarding claims 24-26, 28-31, Campbell illustrates in Figure 6 the casting riser pan wall having an upper and lower portion and a protruding transverse shoulder (140) extending inwardly between the two. Campbell also discloses the top portion of the protrusion being narrower than the bottom with the orientation element of the cover comprises a recess.

Art Unit: 3635

Regarding claim 30, see modified Figure 6 of Campbell above. The indentation in the inner wall is labeled, which defines one of the multiple protrusions in the cover (10).

Regarding claims 32-35, and 39, Campbell illustrates in Figure 6 a casting riser pan comprising:

- A securing element extending radially inward from the bottom portion of the wall (see modified figure above);
- A weakened region connecting the securing element to the bottom portion;
- A securing element including attachment holes (142) with fasteners;
- An end portion to be received by a stackable riser (120).

The examiner notes that it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (In re Hutchison, 69 USPQ 138).

Regarding claims 36 and 37, Campbell illustrates in Figure 6 an annular anchor element (see modified figure above) extending radially outward from the outer wall.

Regarding claim 40, Campbell illustrates in Figure 6 (see modified figure above), a casting riser pan (130) with the end portion including an axially extending upstanding wall.



Art Unit: 3635

Regarding claim 41, Campbell illustrates in Figure 6 a casting riser pan (130) in combination with a stackable riser (120).

Regarding claims 43-46, Campbell illustrates in Figure 1 the casting riser pan and cover in combination with a concrete structure (14).

Regarding claim 47, given the structure of Campbell, as described above, the method for forming an opening in the concrete and inserting the pan and cover would have been inherent and obvious to one having ordinary skill in the art at the time of invention.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell (US Patent Application Publication Number US 2002/0166291) in view of Meyers (US Patent 5852901). It is described above what is disclosed by Campbell; however the reference does not teach ribs on the inside and outside of the pan. Meyers illustrates in Figure 1 a plurality of ribs on the inside and outside of the casting riser pan (10). It would have been obvious to one of ordinary skill in the art, with the motivation of strengthening the walls (Meyers, column 5, lines 48-50) to modify the casting riser pan of Campbell with the plurality of ribs of Meyers.

### ***Response to Arguments***

Applicant's arguments filed 11/21/2007 have been fully considered but they are not persuasive. It appears that the only argument that exists is:

Art Unit: 3635

"The examiner rejected claim 1 as filed on the ground that Campbell purportedly discloses, among other features recited in claim 1, an "annular wall including an orientation portion forming an orientation element." *The structure of Campbell that the examiner interprets as an orientation element, however, is not an orientation element but instead is a seat for supporting a cover without respect whatsoever to the cover's orientation on the seat relative to the riser pan, as further recited in Applicant's claim 1.*"

The examiner disagrees with this assertion. The structure that the examiner interprets as the orientation element is indeed an orientation element. The structure orients both the pan and cover into a shut or closed position with an angular orientation of 0 or 90 degrees depending on where your axis is. The argument that it does not effect the cover's orientation relative to the riser pan whatsoever is simply incorrect. The orientation element effects how and where the cover sits on the pan. The amendments made to the claims do not set forth any additional structure to render the claims allowable or distinguished from the prior art of record. The wall of the pan has an opening corresponding to the removable cover. The cover has many orientation elements corresponding to and mating to the orientation element of the pan to facilitate the seating of the cover.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

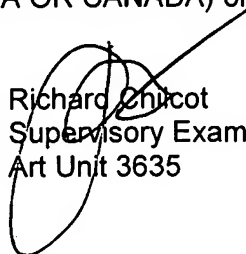
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MARK R. WENDELL** whose telephone number is (571)270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard Chilcot** can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard J. Chicot  
Supervisory Examiner  
Art Unit 3635

/M. R. W./  
Examiner, Art Unit 3635  
January 14, 2008